UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,049	01/16/2004	Michael E. Clark	17145.002003	8489

22511 7590 09/29/2005

OSHA LIANG L.L.P.
1221 MCKINNEY STREET
SUITE 2800
HOUSTON, TX 77010

EXAMINER	
LOWEN, ALYSSA	
ART UNIT	**PAPER NUMBER**
3714	

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/760,049	CLARK ET AL.	
	Examiner	Art Unit	
	Alyssa M. Lowen	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/23/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *foreign patent*.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 9/23/04 is in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. Accordingly, the information disclosure statement is being considered by the examiner.

Priority

2. Applicant's claim for domestic priority under 35 U.S.C. 119 (e) is acknowledged. Provisional applications (Application No. 60440482 and 60441361) upon which priority is claimed meet the necessary requirements and the non-provisional application was filed within the required one-year time frame. However, the disclosure of the prior-filed provisional application, Application No. 60/444361, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for this application. The previously filed provisional application does not relate to an invention disclosed in this application nor are the inventors the same, therefore, priority is not granted under this provisional application.

Specification

3. The disclosure is objected to because of the following informalities: In the first sentence regarding a claim for priority the incorrect serial number (60444361) needs to be changed to the appropriate serial number. Also, in referencing a provisional application in the specification no relationship between the two applications should be specified therefore, the reference to this application being a "continuation-in-part" is incorrect. In paragraph 47, reference is made to Fig. 13 but the described matter

relates to Fig. 15, the word "by" is misspelled and heat is referenced by number "80" when the number "180" is meant. In paragraph 48, reference is made to Fig. 12 but the described matter relates to Fig. 16. Paragraph 51 mentions plastic twice as number "116" but the reference number "316" should be used instead. Appropriate correction is required.

Claim Objections

4. Claims 8,13,17 and 19 are objected to because of the following informalities, a misprint of the word "the" appears on line 3 of claim 8. The word "next" appears as "nest" in section "a" of claim 13 (line 5). In section "a" of claim 17 the word "dried" appears as "dries" in the claim. In part "a" of claim 19 the phrase "plurality pad printing print pads" is confusing and hard to read. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 14-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the word "associated" in part "e" of claim 14 could be confusing since its not clear if the raised feature needs to be physically joined or connected to the likeness of the sports personality or if it needs to be related to or pertaining to the likeness. Therefore, claims 15-23 are unclear by association. Claim 19 further recites the limitation "the multiple color printing heads" in section "b" line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-8,10-14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green (2814159) in view of Parks (GB2160113A). Regarding claim 1, Green discloses a nested toy (Fig. 4) having a top half shell body portion (25) and a bottom shell body portion (20) constructed of plastic (column 2 line 3) a material resistant to moisture absorption. The two halves are press fit together at a part line to form a nested toy figure having an exterior surface (Fig. 4). A raised feature or projection (22) is secured on the exterior surface of the toy (Fig. 1). The nested toy can be configured to take the shape of a figure or person (column 1 line 68-71). Green, therefore, discloses the basic inventive concept substantially as claimed with the exception of the likeness of a sports figure or other celebrity secured on the exterior surface of the toy. However, Green is capable of including the likeness of a sports

figure or other celebrity as this is encompassed in "person". Moreover, Parks shows this feature to be old in the nested toy art. Parks discloses nested dolls bearing the likeness of celebrities such as television personalities, sports teams or historical figures (page 1 lines 29-31). It would have been obvious to one of ordinary skill in the art at the time of invention from the teaching of Parks to modify the exterior of Green by adding the likeness of a celebrity in order to keep the attention of a child since it would depict an easily recognizable image. Regarding claim 8, Green shows a raised feature with a top portion and a bottom portion secured to the surface of the toy adjacent to the part-line (Figs. 8 and 9), when the top and bottom shell portions are joined the raised features form a completed feature (column 4 lines 24-27). In regard to claim 13, Green discloses the raised feature on the exterior surface and the top and bottom shell portions of the toy being constructed of plastic. Parks discloses a set of nested toy figures with a plurality of pairs of top and bottom shell portions that fit together along a part line where each figure is of a size smaller than the next larger figure so one can fit within another (page 1 lines 5-13). Also disclosed is the likeness of a sports figure or celebrity located on the exterior of the toy and each of the likenesses comprising one of a team of sports personalities (page 1 line 20 and 29-30). Regarding claim 14, Green discloses a method of constructing a nested toy figure (Fig. 4) by disclosing molding a top (25) and bottom portion (20) of a nested figure of plastic (column 2 lines 1-4) that are connected together to form an exterior surface (Fig. 1). A raised feature (22) can be related to the object (column 4 lines 25-26) or joined to the exterior of an object (Fig. 1) where a likeness of a celebrity or sports personality is found, since Parks describes the

use of a celebrity likeness. In regard to claim 20, the raised feature is integrally molded onto the shell body of the nested toy figure (column 2 lines 1-2).

10. With regard to claims 2-7 and 10-12, the above references disclose each and every structural element of the nested toy figure set forth in claim 1 as described in detail above. The references teach a nested toy figure with raised features constructed of molded plastic with a painted image on the exterior, but is silent to the method of molding. In claims 2-4, the raised feature being either formed integrally or glued to the exterior shell of the toy with both the shell and raised features being a press molded mixture of wood and resin is being treated as a product by process limitation. In claims 5-7, the raised feature being either formed integrally or glued to the exterior shell of the toy with both the shell and raised features being formed of injection molded plastic is being treated as a product by process limitation. Claims 10-12 drawn to the images of the celebrity being printed on a sheet adhered to the surface of the toy, being printed directly on the surface, and an ink/paint image transferred and secured onto the surface respectively are being treated as product by process limitations. As set forth in MPEP 2113, product by process claims are not limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 USC 103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113. Thus, even though the references disclose a different process, it appears that the product of the references, Green and Parks, would be the same or similar as that claimed.

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Green and Parks as applied to claim 1 above, and further in view of Pino (D489100). The nested toy of Green and Parks discloses the basic inventive concept substantially as claimed with the exception of the raised feature being an arm, hand, ball, bat, collar or sleeve. Pino, however, shows a nested doll with a raised feature in the form of an arm (Fig. 1) showing this feature to be old in the art. It would have been obvious to one of ordinary skill in the art at the time of invention from the teaching of Pino to modify the raised feature of Green and Parks to include an arm in order to have a more realistic looking doll.

12. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Green and Parks as applied to claim 14 above, and further in view of Akers (3230124). The toy of Green and Parks discloses the basic inventive concept substantially as claimed with the exception of the top and bottom portions of the toy figure being a press molded mixture of wood and resin. Akers discloses a wood and resin mixture (column 3 paragraph 1) used to press mold an object in this case a bowling pin (Fig. 1), which has a similar structure to that of a doll. Parks disclosed that wood is a commonly used material in the construction of nested toy dolls (page 1 line 8); therefore Akers disclosure that the wood and resin mixture can be used to replace wood (column 1 paragraph 5) shows this feature to be old in the art. It would have been obvious to one of ordinary skill in the art at the time of invention from the teaching of Akers to modify the device of Green and Parks to be constructed of a press molded wood and resin

mixture in order to create a hard, strong and water resistant device (column 1 paragraph 8).

13. Claim 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Green and Parks as applied to claim 14 above, and further in view of Cohen (20020076513). The nested toy of Green and Parks discloses the basic inventive concept substantially as claimed with the exception of the top and bottom portions of the toy figure being formed by injection molding of a plastic material. Cohen discloses upper and lower shell portions being formed by injection molding (paragraph 35 line 6). It would have been obvious to one of ordinary skill in the art from the teaching of Cohen to have the nested toy of Green and Parks constructed by injection molding since it is an effective way to produce multiple parts to be fit together.

14. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Green and Parks as applied to claim 14 above, and further in view of Sullivan (2700619). The method of Green and Parks discloses the basic inventive concept substantially as claimed with the exception of the celebrity image being printed on a sheet of paper coated with dried glue and transferring the image to the surface of the toy figure by moistening the paper and drying the image onto the surface. However, Sullivan shows this feature to be old in the surface decorating art. Sullivan discloses paper coated with a dry adhesive (column 1 line 22) with an image printed thereon that will be transferred to the surface to which it is applied (column 1 lines 16-19). The image is transferred by dipping the sheet in water (column 4 lines 7-8) and pressing it to the surface to which it is to be applied (column 4 lines 16-19) then removing the paper leaving the image

behind and once dry the image is attached to the surface since water can be used to clean the surface of excess adhesive if necessary without disturbing the image (column 4 line 35). Although Sullivan does not disclose the image being a likeness of a celebrity it does teach how to attach an image to a surface. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention from the teaching of Sullivan to make the celebrity image of Green and Parks attachable by this method in order to create an image more quickly on a surface than if the image were to be painted or glued to the surface by hand.

15. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Green and Parks as applied to claim 14 above, and further in view of Rebstock (4996087). The method of Green and Parks discloses the basic inventive concept substantially as claimed with the exception of the image of the celebrity image being printed onto a sheet of heat shrinkable plastic the sheet being wrapped around a toy figure and heating the plastic to attach the image to the toy. However, Rebstock discloses an image imprinted on heat shrinkable plastic (Fig. 2) that is wrapped around an ornament (Fig. 3) and then heated to attach the image to the object (Fig. 4). Although, Rebstock does not expressly disclose the image being the likeness of a celebrity, the image can be of any nature chosen by an individual user (column 4 paragraph 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention from the teaching of Rebstock to make the celebrity image of Green and Parks attachable by this method in order to create an image more quickly on a surface than if the image were to be painted or glued to the surface by hand.

16. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Green and Parks as applied to claim 14 above, and further in view of Dietz (6276266). The method of Green and Parks discloses the basic inventive concept substantially as claimed with the exception of the image of a celebrity being formed by pad printing where separate primary colors are placed on a plurality of printing pads and stamped onto the shell of the toy to form a multiple color image. Dietz discloses that pad printing is a known way to print on curved or non-flat surfaces (column 1 lines 9-11) by using multiple color printing heads for the primary colors, blue, yellow and magenta (28) the image is printed on a release media (30) that is then picked up by the multiple printing pads (54) and stamped onto the object (Fig. 3). Although, Dietz does not specifically disclose a nested toy figure, it does relate to printing on non-flat surfaces, which would include toy figures. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention from the teaching of Dietz to make the celebrity image of Green and Parks attachable in this manner in order to create an image more quickly on a surface than if the image were to be painted or glued to the surface by hand.

17. Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green and Parks as applied to claim 14 above, and further in view of Shlopak (5356035). Green and Parks disclose the basic inventive concept substantially as claimed except for the raised feature being separately molded and glued to the shell body of the nested toy figure. Shlopak, however, teaches using injection molding to create the components or raised features of the device in this case the arms and legs (column 3 line 7) and gluing them to the body of a toy figure (column 3 line 14) showing

this feature to be old in the toy figure art. It would have been obvious to one of ordinary skill in the art from the teaching of Shlopak to modify the toy of Green and Parks by having the raised feature glued to the exterior surface so that the molds for the top and bottom of the toy would be simpler since the more complicated part would be attached at a later time.

18. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Green, Parks and Shlopak as applied to claim 21 above, and further in view of Akers. The method of Green, Parks and Shlopak discloses the basic inventive concept substantially as claimed with the exception of the molded raised feature being a press-molded mixture of wood and resin. However, Akers discloses this feature to be old in the molding art. It would have been obvious to one of ordinary skill in the art at the time of invention from the teaching of Akers to construct the raised feature of a press molded mixture of wood and resin in order to create a hard, strong and water resistant device.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Lowen whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Chanda Harris can be reached on 571-272-4448. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AML

Chanda L. Harris

CHANDA L. HARRIS
PRIMARY EXAMINER